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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,195	05/23/2000	Kia Silverbrook	NPA002US	9147

24011 7590 12/15/2004

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

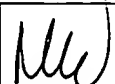
HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/575,195	<b>Applicant(s)</b> SILVERBROOK ET AL.	
	<b>Examiner</b> Calvin L Hewitt II	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-59 have been examined.

***Response to Amendment/Argument***

2. The Examiner maintains the 112 1<sup>st</sup> rejection to claims 1-59 as the Specification is silent regarding the use of a sensing device in the purchasing method described in pages 73-80 of Applicant's Specification. Regarding the 112 second paragraph rejection, Applicant's response clearly states that the claims 1-59 are directed to the method found on pages 73-80 in Applicant's Specification ("Lastly the system for purchasing as claimed in claims 1-59, is described in detail on pages 73-80 of the description") and such a method is implemented, at least in part, online (Specification, page 77, lines 10-18; page/line 79/4-80/4). Therefore, the Examiner also maintains the 112 second paragraph rejection to claims 1-59.

Buckley et al. teach a pen that interacts with a form and generates data based on a reference point, sensing device movement and position (figures 1, 4, 5, 8 and 9) and a computer for receiving said data (4, 5, and 9).

The Examiner maintains the rejection to claims 1-59.

The following assertion of facts have gone unchallenged and therefore are considered prior art:

- electronically or manually distributing, downloading, printing and copying order forms
- collecting and binding (e.g. staples, paper clips, rubber bands) forms

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 4, 5, 29, 32, 33, and 49 are dedicated to online purchasing using a "sensing device". Specifically, the claims recite interactions between a form and the sensing device. However, the Applicant's Disclosure is silent regarding the use of a sensing device, such as a pen (Specification, page 73, lines 21-26),

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when a customer desires to order goods and services online (Specification, page/line 73/21-81/19).

Claims 2, 3, 6-28, 30, 31, 34-48 and 50-59 are also rejected as they depend from claims 1, 4, 5, 29, 32, 33, or 49

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 5, 29, 32, 33, or 49 teach an online purchasing system using forms (Specification, page/line 73/21-81/19). The Applicant teaches the forms as "paper" or "netpages" (i.e. interactive printed pages) (Specification, page 15/8-16/10; page 75, lines 3-15) however, the Applicant's purchasing method is online (Specification, page/line 73/21-81/19; claims 1, 4, 5, 29, 32, 33 and 49) therefore, the scope of the Applicant's invention is not apparent. Further, it is not clear how the sensing device interacts with these forms.

Claims 2, 3, 6-28, 30, 31, 34-48 and 50-59 are also rejected as they depend from claims 1, 4, 5, 29, 32, 33, or 49

7. Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a netpage application running on a netpage server, downloading and printing a netpage from the netpage server, and a customer interacting with a netpage to order goods and services (figure 2)

Claims 2, 3, 6-28, 30, 31, 34-48 and 50-59 are also rejected as they depend from claims 1, 4, 5, 29, 32, 33, or 49.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-10, 19, 20, 29-37, 41, 42, and 46 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Buckley et al., U.S. Patent No. 6,446,871.

As per claims 1-10, 19, 20, 29-37, 41, 42, and 46 Buckley et al. teach a method and system for enabling online purchasing comprising:

- a form (which includes all required information relating to the purchase transaction) containing information (that relates to an item to be purchased and order acceptance) and including coded data (substantially invisible) indicative of an identity of the form and a reference point of the form (figures 1, 4, 5 and 7-9)
- receiving in a computer system, indicating data from a sensing device (with a nib) regarding the identity of the form, and a position of the sensing device relative to the form, and when placed in a position relative to the form, sensing the indicating data using at least some of the coded data (figures 1, 4, 5 and 7-9; column 4, lines 55-61; column/line 10/65-11/6)
- identifying in the computer system and from the indicating data, at least one parameter relating to the purchasing transaction (figures 1, 4, 5 and 7-9; column 3, lines 10-41; column/line 5/10-6/13)
- wherein the parameter is associated with a zone and identifying in the computer system and from the zone relative to which the sensing device is located said parameter (figures 1, 4, 5 and 7-9)

- wherein said parameter is an action (or option )parameter (e.g. purchase information, selecting an item for purchase, a quantity of an item, viewing a shopping cart and submitting an order) and effecting an operation in said computer system using said action (or option) parameter (figures 1, 4, 5 and 7-9; column/line 5/10-6/13)
- wherein said coded data is superimposed with a visual graphic, the visual graphic relating to the parameter associated with the coded data (figure 1; column 5, lines 8-38)
- receiving, and interpreting, in the computer system data regarding movement of the sensing device using at least some of the coded data (figures 1, 4 and 5)
- the computer system sensing a hand drawn mark using the sensing device (figures 1, 4, 5 and 7-9)

Buckley et al. teach a pen that interacts with a form and generates data based on a reference point, sensing device movement and position (figures 1, 4, 5, 8 and 9) and a computer for receiving said data (4, 5, and 9).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871, in view of Wolff et al., U.S. Patent No. 6,081,261 and Bezos et al., U.S. Patent No. 5,727,163.

As per claims 11 and 38-40, Buckley et al., teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). However, Buckley et al. do not specifically recite parameter data as shipping address, shipping method, payment method or card type. Wolff et al. teach a form processing method where a sensing device is used to generate a corresponding electronic document from an off-line document (column 2, lines 50-56) while Bezos teaches order forms that require users to provide data such as shipping address, shipping method, payment method or card type. Therefore, it would have been obvious to combine the teachings of Buckley et al., Wolff et al. and Bezos in order to more efficiently and accurately order products and services.

12. Claims 12-18, 26, 43 and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of in

view of Wolff et al., U.S. Patent No. 6,081,261 and Thompson-Rohrlich, U.S. Patent No. 5,500,937.

As per claims 12-18, 26, 43 and 52-59, Buckley et al., teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). Buckley et al. also teach detecting sensing device data, such as text, using an accelerometer (column 12, lines 15-27) and wirelessly transmitting sensing device data. However, Buckley et al. do not specifically recite parameter data as shipping address, shipping method, payment method or card type. Wolff et al. teach a form processing method where a sensing device is used to generate a corresponding electronic document from an off-line document (column 2, lines 50-56) while Thompson-Rohrlich teaches entering handwritten text (e.g. authorization signature, quantity) data using a sensing device, for effecting an operation in a computer system (abstract; figures 1-3). Wolff et al. also teach signature verification ('261, column 2, lines 57-61). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al., Wolff et al., and Thompson-Rohrlich in order to more efficiently process orders by automating the order authorization function ('937, figures 1 and 2).

As per claims 52-59, Thompson-Rohrlich teach digital ink and biometric data (figures 2-10c). Wolff et al. teach biometric data such as pen tilt, pen force, or fingerprint data (column 2, lines 57-62; column/line 7/5-8/67) and coded data as barcodes (macrodots, having corners, substantially invisible and provided with infrared absorbing media) (abstract; figures 5 and 6; column/line 7/5-8/67), and Buckley et al. teach wireless sensing devices (column 4, lines 55-61; column 7, lines 20-42), printing on surfaces that are part of a product or package (figure 1; column 5, lines 9-36), and coded data as barcodes (macrodots, having corners, substantially invisible and provided with infrared absorbing media) (figures 1, 4, 5, 8 and 9; column 4, lines 55-61; column 7, lines 20-42)

13. Claims 21-23, 25, 28, 44, 45, 48, and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871.

As per claims 21-23, 25, 28, 44, 45, 48, and 49-51, Buckley et al., teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). Buckley et al. do not specifically recite printing forms. However, electronically or manually distributing, downloading, printing and copying order forms are old and well-known and it would have been obvious to one of ordinary skill to allow users to access supplemental forms in case of mistakes or to place additional orders. Similarly,

collecting and binding (e.g. staples, paper clips, rubber bands) forms are also well-known. Buckley et al. also teach detecting sensing device data using an accelerometer (column 12, lines 15-27).

14. Claims 24 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Wolff et al., U.S. Patent No. 6,081,261.

As per claims 24 and 47 Buckley et al. teach a method and system for conducting online purchases comprising a sensing device interacting with a form for reading and transmitting parameter data to a computer system (figures 1, 4, 5, and 7-9; column 5, lines 29-38). However, Buckley et al. do not specifically recite storing forms. Wolff et al. teach automated form processing comprising generating electronic forms from a hard-copy original using a sensing device (abstract; column 2, lines 50-57). Wolff et al. also teach form management where a form can be retrieved from an archive by means of a database search (column 3, 10-20). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al. and Wolff et al. in order to allow users more efficiently access archived data.

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and  
after-final communications),

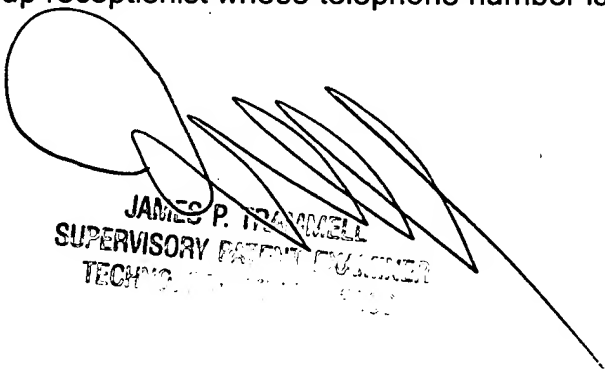
or:

(703) 746-5532 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.

Calvin Loyd Hewitt II  
December 9, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNICAL STAFF